

REMARKS/ARGUMENTS

Favorable reconsideration of this application is respectfully requested.

Claims 1-38 are pending in this application. Claims 1 and 18 have been amended to even more clearly recite that the first SMS message is from the mobile subscriber station to the telephony/Internet server and that it is only after receipt of this first SMS message that there is a second SMS sent by the telephony/Internet server to the mobile subscriber station. As this message order was clearly present in the previously presented claims and the description found at page 12, lines 8-24 of the specification, for example, no new matter has been added.

The outstanding Office Action presents a rejection of Claims 1-3, 11, 14, 15, 17-20, 28, 31, 32, and 34 as being unpatentable over Bannister et al (U.S. Patent No. 5,943,399, Bannister) in view of Voit (U.S. Patent No. 6,075,783) and a rejection of Claims 4 and 21 as being unpatentable over Bannister in view of Voit in further view of Xu et al. (U.S. Patent No. 6,151,628, Xu) under 35 U.S.C. § 103(a).

Applicants acknowledge with appreciation the allowance of Claims 5-10, 12, 13, 16, 22-27, 29, 30, 33, and 35-38.

Before considering the outstanding prior art based rejections, Applicants again believe that a brief review of the present invention would be helpful. In this respect the present invention defined by the rejected claims includes, *inter alia*, a communication system and corresponding method adapted to enable a telephone/Internet connection between a mobile subscriber station of a cellular radio communication network and a specified Internet user the mobile subscriber station is seeking to establish a connection with. The cellular radio communication network includes a short message service (SMS) and the communication system includes a telephony/Internet server adapted to facilitate establishment of the desired telephone/Internet connection. In operation, the SMS provides a first SMS message

from the mobile subscriber station to the telephony/Internet server that identifies the Internet address of the specified Internet user that the mobile subscriber station would like to place a telephone call to. The telephony/Internet server then replies to receipt of this inquiry information in the first SMS by sending a second SMS to the mobile subscriber station which, at a minimum, specifies if the telephony/Internet connection sought by the mobile subscriber station is possible and the telephony/Internet server's telephone number.

Turning to the rejection of Claims 1-3, 11, 14, 15, 17-20, 28, 31, 32, and 34 as being unpatentable over Bannister in view of Voit it is first noted that there is nothing in the relied upon teachings of Bannister and/or Voit that can be said to reasonably teach or suggest all of the subject matter of amended apparatus base independent Claim 1 or that of amended method base independent Claim 18.

In this regard, amended apparatus base independent Claim 1 requires, *inter alia*, that the SMS is to transfer inquiry information identifying an Internet address for said specific Internet user “as part of a first SMS message from said mobile subscriber station to said telephony/Internet server and to transfer return information as a second SMS from said telephony/Internet server to said mobile subscriber station after receipt of the first SMS at said telephony/Internet server, said second SMS specifying at least if the telephony/Internet connection being sought by the mobile subscriber station is possible and the telephony/Internet server's telephone number”(emphasis added). Similarly, amended method base independent Claim 18 requires “using a short message service (SMS) of the cellular radio communication network to send a first SMS message with inquiry information identifying the Internet address for said specific Internet user from said mobile subscriber station to a telephony/Internet server; and sending return information as a second SMS message from said telephony/Internet server to said mobile subscriber station after receipt of

the inquiry information by the telephony/Internet server, the second SMS message specifying at least if the telephony/Internet connection indicated by the Internet address for said specific Internet user is possible using the SMS and the telephony/Internet server's telephone number" (emphasis added).

First, there is no disclosure or suggestion in Bannister that the SMS is to transfer inquiry information identifying an Internet address for any specific Internet user, much less that this inquiry information is to be transmitted "as part of a first SMS message from said mobile subscriber station to said telephony/Internet server." The outstanding Action reliance upon col. 3, line 44 to col. 7, line 57 of Bannister as somehow presenting such a teaching is in error because it is either a misinterpretation of these teachings of Bannister or it reflects a failure to properly analyze this limitation of Claim 1 and similar limitation of Claim 18.

The teachings of col. 3, lines 44- 65 of Bannister are that work station 100 has a modem 106 for data transmission over the PSTN 200 to provide access to the Internet 300. The telephone 110 located near work station 110 (e.g., in the same house as workstation) is simply a voice terminal also connected to PSTN 200, but not through a modem. On the other hand, col. 3, line 66 to col. 4, line 21 discloses workstation 400 is connected to the Internet 300 via a gateway 304 and local area network (LAN) 410 and that this workstation also has an associated voice terminal 420 that connects to the PSTN 200 via a private branch exchange 430. Once again, the voice terminal has a separate voice channel. Accordingly, while data service node 500 is provided to forward web pages over the Internet 300 to the requesting workstation 100 or 400, as taught at col. 4, lines 22-34 of Bannister, any voice communications is over the standard PSTN 200, not via the Internet 300.

Furthermore, the requests for page data to the service node 500 come from the workstations (100 or 400) via the Internet 300, there are no requests disclosed as starting from the mobile terminals 650. See col. 5, lines 11-21. While information returned from the

service node can include icons for the corresponding workstation operator to select which are to “originate a voice call to the mobile terminal 650 or to send a short message to the mobile terminal 650” (emphasis added) this is still not the claimed subject matter requiring that the SMS service is to transfer inquiry information identifying an Internet address for a specific Internet user “as part of a first SMS message from said mobile subscriber station to said telephony/Internet server” (emphasis added).

Thus, in Bannister it is the work station that initiates a page request, see col. 5, lines 31-36 and note the text from the service node to the workstation 100 mentioned at col. 5, lines 31-36 is not an “SMS message from said mobile subscriber station to said telephony/Internet server” (emphasis added). Instead, this is part of the page data sent from the service node 500 to the requesting work station as the response to the page data request from that workstation. It is only after a workstation requests a voice call to the mobile station that the service node 500 transfers this workstation request to the GSM system 600, as fully explained at col. 5, lines 23-col. 6, line 21.

It is within this full context of Bannister that the teachings of col. 6, lines 8-31 as to short message communications between the service node 500 and the GSM system 600 must be viewed. As noted in In re Wesslau, 147 USPQ 391, 393 (CCPA 1965) “it is impermissible within the framework of §103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” Also note In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000):

While the test for establishing an implicit teaching, motivation, or suggestion is what the . . . statements of [the reference] would have suggested to those of ordinary skill in the art, the . . . statements cannot be viewed in the abstract. Rather, they must be considered in the context of the teaching of the entire reference.

Clearly, the discussion of col. 6, line 59 to col. 7, line 7 of Bannister also cannot be taken out of context and then expanded into a teaching that applies to the short message communications between the service node 500 and the GSM system 600. In this regard the general discussion of col. 6, line 59 to col. 7, line 7 as to how the SMS service insures delivery of SMS messages to intended mobile terminals cannot be reasonably said to teach some kind of SMS request message originating at a mobile station 650 that seeks to have service node 500 contact any particular workstation (100 or 400), much less an SMS message of the Claim 1 required content (identifying an Internet address for said specific Internet user). There is also no teaching or suggestion that such an untaught SMS message would result in the service node 500 transferring “return information as a second SMS from said telephony/Internet server to said mobile subscriber station after receipt of the first SMS at said telephony/Internet server” (emphasis added), much less a second SMS message of the required content (“specifying at least if the telephony/Internet connection being sought by the mobile subscriber station is possible and the telephony/Internet server's telephone number”(emphasis added)).

In this last regard, col. 7, lines 8-57 of Bannister simply teach that the service node 500 will relay mobile station status information to the requesting work station as part of the requested page data. There is no teaching here or elsewhere in Bannister that suggests anything like the claimed “first SMS message from said mobile subscriber station to said telephony/Internet server” (emphasis added). Further, the teaching of the workstation sending an associated voice terminal telephone number to the service node 500 is not readable as this “first SMS message” as it is not an SMS message and it is also not “from said mobile subscriber station to said telephony/Internet server (emphasis added). Also, while this telephone number is then forwarded to the service node 500 that sends it to the GSM system

600, these transfers are also not “from said mobile subscriber station to said telephony/Internet server” (emphasis added), and are also not disclosed to be SMS messages.

Moreover, this telephone number of the workstation telephone is disclosed by Bannister to be used directly by Gateway MSC 610 in GSM system 600 to establish a normal voice channel over the PSTN 200 to the indicated voice terminal that will then be coupled to the mobile terminal 650. This has nothing to do with the above-noted two SMS messages that must be sent as in Claim 1, much less does it teach the claimed content of either of these SMS messages. It in fact teaches away from the actual subject matter of Claim 1 as there is no “telephony/Internet connection between a mobile subscriber station . . . and a specific internet user, just a telephony connection of voice terminals.

While col. 7, lines 58-63 of Bannister do discuss the use of SMS messages to establish communication from a workstation (not the associated voice terminal at the workstation) to a mobile terminal 650, this also teaches away from the above-noted Claim 1 subject matter. The process for such direct SMS messaging is then taught at col. 7, line 64 to col. 8, line 63, including the discussion of col. 8 lines 1-5 that is apparently mistakenly relied on at page 2 of the outstanding Action along with lines 58-67 of col. 7 that also relate to direct SMS messaging between the workstation and the mobile terminal.

The FIG. 4 and the col. 9, line 7 to col.10, line 67 teachings of Voit, noted at page 3 of the outstanding Action do not cure the above noted deficiencies of Bannister any more than the more detailed actual discussion of FIG. 4 (starting at line 1 of column 11 of Voit) does. Accordingly, the rejection of Claim 1 is traversed because even if there were some reason to combine the teachings of these references, which is not the case here as discussed below, there would still be no valid case of *prima facie* obviousness established. See MPEP §2143.03 and the cases-cited therein that establish that a valid *prima facie* case of obviousness requires that all claim limitations must be taught or suggested.

As the step limitations of base independent method Claim 18 closely parallel the apparatus limitations of base independent apparatus Claim 1, the rejection of this claim is also traversed for the reasons noted above as to Claim 1.

In addition, as Claims 2, 3, 11, 14, 15, and 17 all ultimately depend from Claim 1 and include all the limitations thereof, and as Claims 19, 20, 28, 31, 32, and 34 all ultimately depend from Claim 18 and include all the limitations thereof, the rejection of these claims as being unpatentable over Bannister in view of Voit is also traversed for the reasons noted above as to the respective base parent independent Claims 1 and 18. Moreover, each of the dependent claims add further features not taught or suggested by Bannister in view of Voit and this rejection of these dependent claims is traversed for this reason as well.

Turning to the rejection of Claims 4 and 21 as being unpatentable over Bannister in view of Voit in further view of Xu, it is noted that Xu does not correct the above-noted deficiencies of Bannister and/or Voit. Accordingly, even if actual and reasonable motivation had been established to combine the teachings of all of these clearly disparate references, which is not the case, the result would still not include all the subject matter of base independent Claims 1 or 18. Therefore, as Claims 4 ultimately depends from base Claim 1 while Claim 21 ultimately depend on base Claim 18, their rejection as being unpatentable over Bannister in view of Voit taken with Xu is traversed for the reasons noted above as to these respective base independent claims. Moreover, each of these dependent claims add further features not taught or suggested by Bannister in view of Voit taken with Xu and this rejection of these dependent claims is traversed for this reason as well.

Besides the lack of a teaching of each and every claim limitation noted above, there also has been no reasonable establishment of a reasonable basis that would have led the artisan to attempt to modify the Bannister system by the disparate “follow-me” type routing teachings of Voit, or the equally disparate teachings of Xu.

In this last regard, the Bannister system is taught to provide a request for a page of data specifying a particular mobile terminal to a service node. This service node sends out a terminal status request to the communications system that services the particular mobile terminal, all as discussed in detail above. Thus, the system of Bannister would not need and could not use the Internet telecommunication system teachings of the system of Voit (that checks for mobile telephone service after checking PC availability by pinging) that is described at col. 11, line 1- col. 12, line 43, not at col. 9, line 7- col. 10, line 67 as urged at page 3 of the outstanding Action.

Col. 9, line 7- col. 10, line 67 of Voit describe the systems of FIGS. 2 and 3 involving a domain name address or telephone number request from a PC 10 input to the Internet 12 via an internet access server 11 to be processed by an Domain name server 13 (shown in detail in FIG 3). There is no relationship of the domain name or telephone conversion to an IP address and its return to an inquiring PC performed by the addressable lookup process of FIG. 3 (col. 9, lines 29-45) Voit and the teaching of Bannister of the service node receiving a particular terminal status message from the communications system that will be a wireless communication system when the particular terminal is a mobile voice terminal.

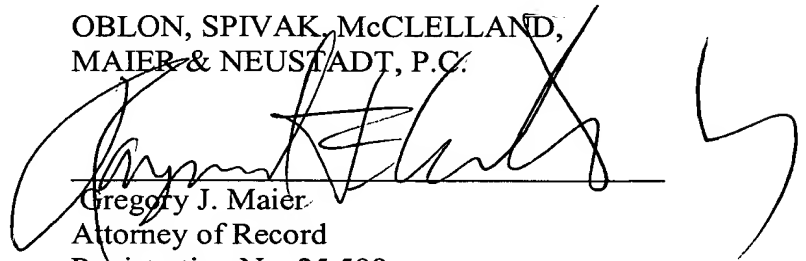
In this last respect and as noted in the last response, it is well established that there must be a valid suggestion or motivation presented by the PTO to support the proposed modification to the references as fully discussed in MPEP §2143.01. The system of Bannister would have no use for the return of an IP address in response to the inquiry taught there as to the system of Voit. Similarly, the Action fails to establish any reasonable basis to modify either Bannister or Voit based upon the system taught by Xu. . Accordingly, as no reasonable motivation had been established to combine the teachings of all of these clearly

disparate references, the rejections offered as to unpatenability over Bannister in view of Voit alone or in view of these references taken with Xu are traversed for this reason as well.

In view of the foregoing amendment and remarks, it is respectfully submitted that no further issues remain outstanding in the present application, and that this application is clearly in condition for formal allowance and an early and favorable action to that effect is, therefore, respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

A large, stylized handwritten signature in black ink, likely belonging to Gregory J. Maier, is written over a horizontal line. To the right of the signature is a large, handwritten number '4'.

Gregory J. Maier
Attorney of Record
Registration No. 25,599
Raymond F. Cardillo, Jr.
Registration No. 40,440

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/03)